

REMARKS

Claims 1-14, 16-29, 31-53, 57 and 59-80 are pending. By this amendment, claim 42 is amended.

I. February 10, 2003 Telephone Interview

The February 10, 2003 telephone interview between Examiner Kim and Applicant's representative Mr. Hunt is made of record. The courtesies extended by Examiner Kim during the interview are gratefully acknowledged. The substance of discussions during the interview are incorporated into the following remarks.

During the interview, Examiner Kim and Mr. Hunt discussed the claimed feature of a transaction card assembly having a transaction card portion attached to an auxiliary portion in an edge-to-edge fashion so the transaction card portion can be separated from the auxiliary member without tools and meet ANSI and ISO specifications for edge roughness after separation. Mr. Hunt clarified that the transaction card portion would meet the edge roughness specifications without any post separation processing. Examiner Kim questioned whether such an assembly could be made. Applicant's representative Mr. Hunt offered to provide samples of transaction card assemblies that fall within the claims of this application to show that such a transaction card assembly has been made by the Applicant.

Accordingly, enclosed are five sample transaction card assemblies for the Examiner's review. These assemblies are provided in one-piece condition so that the transaction card portion is attached to the auxiliary member. That is, these samples are made from one piece of sheet material and a line of weakness (in this case, a scoring in the sheet material) separates the transaction card portion from the auxiliary member. The Examiner is invited to test the enclosed samples by bending the assembly at the line of weakness so that the transaction card portion is separated from the auxiliary member. Applicant has tested several similar assemblies from the same lot as the enclosed samples and found that the transaction card portion on those assemblies met ANSI and ISO specifications for edge roughness after separation. That is, after separation, all of the edges of the transaction card portion, including the edge along which the line of

weakness was formed and the auxiliary member was attached, were sufficiently smooth after separation to meet the applicable ANSI and ISO specifications for edge roughness.¹

II. The Claims Define Patentable Subject Matter

Item 2 of the Office Action rejects claims 1-14, 21-27, 29, 31-24, 38-53, 57 and 59-80 under 35 U.S.C. §103(a) over U.S. Patent 6,039,356 to Warther et al. in view of U.S. Patent 6,036,099 to Leighton. Item 3 of the Office Action rejects claims 19, 20, 36 and 37 under 35 U.S.C. §103(a) over Warther et al. and Leighton in view of U.S. Patent 6,328,341 to Klure. These rejections are respectfully traversed.

In order to establish a prima facie case of obviousness under §103 based on a combination of elements disclosed in different prior art references, “[f]irst, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success.” MPEP §2143 and §2143.02. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in the applicants’ disclosure.” MPEP §2143. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

During the telephone interview, Examiner Kim inquired whether independent claims 1, 28, 57, 78 and 79 are intended to be interpreted as meaning that the transaction card meets ANSI and ISO specifications for edge roughness after separation without any post separation processing, such as grinding, cutting or other operations to remove burrs or other features at the edges of the card. This is indeed what is intended by these claims. That is, the claims are intended to cover arrangements in which the transaction card may be separated from an auxiliary member or other transaction card without tools and meet ANSI and ISO specifications for edge roughness immediately after separation and without any further processing of the transaction card. In fact, a transaction card cannot meet ANSI and ISO specifications for edge roughness unless all edges of the card are suitably smooth, in this case including the edge(s) of the transaction card that may have been previously attached to an auxiliary member.

¹ Although the enclosed samples are “gift cards”, these cards are “dead” and have no cash or credit value.




When informed of the above, Examiner Kim expressed that he was doubtful whether such an arrangement could in fact be made. As mentioned above, Applicant encloses sample transaction card assemblies that the Examiner is free to use to confirm that such a transaction card assembly can in fact be made. It should be appreciated, however, that the claims in this application are not necessarily limited to the enclosed samples.

The notion that transaction card assemblies such as those claimed could not be made successfully, of course, undermines any assertion that it would have been obvious to someone skilled in the art. That is, it is not obvious in view of Leighton to make the transaction card assemblies of Warther so the transaction cards would meet ANSI and ISO specifications for edge roughness after separation from an attached auxiliary member. Examiner Kim's skepticism undermines the propriety of the asserted combination of Leighton and Warther because if these references actually taught or suggested the claimed inventions, there would be no doubt from their disclosures that the claimed inventions could or should be made. Instead, neither of these references teaches or suggests an arrangement in which a transaction card and an auxiliary member joined in an edge-to-edge fashion may be separated from each other without tools such that the transaction card meets ANSI and ISO specifications for edge roughness after separation.

The examiner's doubt that such an arrangement could be successfully made also points out another deficiency in the asserted combination -- there would have been no reasonable expectation of success in modifying Warther's transaction card assembly so that the transaction cards would meet ANSI and ISO specifications for edge roughness after separation. Such a reasonable expectation of success must come from the prior art, including Leighton and/or Warther, but neither of these references teach or suggest that it could be successfully done. Otherwise, Applicant would not need to provide samples to show that at least one illustrative embodiment of the invention could be made.

In view of the above, a prima facie case that one of ordinary skill in the art would have been motivated to modify the Warther transaction card assemblies in view of Leighton to arrive at the claimed inventions has not been made. Warther fails to teach or suggest a transaction card that meets the ANSI and ISO standard in any way, and Leighton discloses only a transaction card that is unattached to any other item and has a surface smoothness in accordance with ANSI and ISO specifications suitable for dye sublimation printing. No teaching or suggestion is made in



either reference that a transaction card could or should meet edge roughness specifications after separation from an attached auxiliary member.

Accordingly, claims 1, 28, 57, 78 and 79, and claims 2-14, 16-27, 29, 31-53, 59-77 and 80 which depend from these independent claims, are allowable for at least the reasons given above. Withdrawal of the §103 rejections is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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